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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/424,181	11/10/99	ROGELJ	S UNME-0054-1

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EXAMINER

LUKTON, D

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 10/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.

09/424,181

Applicant(s)

Rogell

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE one MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) ☒ Responsive to communication(s) filed on Sep 12, 2001

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

4) ☒ Claim(s) 1-35 is/are pending in the applica

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from considera

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claims 1-35 are subject to restriction and/or election requirem

## Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

15) ☐ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

20) ☐ Other:

Pursuant to preliminary amendment, claims 11 12 14 19 have been amended, and claims 20-35 added. Claims 1-35 are pending.

\*

A restriction is imposed; first however, the following subgenera are defined:

**G1:** the PDI inhibitor is limited to those that are encompassed by claim 2 or 8;

**G2:** the PDI inhibitor is limited to those that are encompassed by claim 9;

**G3:** The PDI inhibitor can be whatever the claims permit, provided that G1 and G2 are excluded.

Restriction to one of the following inventions is required under 35 U.S.C. §121:

1. Claims 1-8, 11 drawn to PDI inhibitors that are limited to G1.
2. Claims 1, 9, 10, 20, drawn to PDI inhibitors that are limited to G2.
3. Claim 1, drawn to PDI inhibitors that are limited to G3.
4. Claims 12-15, 19, 21-35, drawn to a method of inhibiting PDI by use of Group 1 compounds.
5. Claims 12-15, 19, 35 drawn to a method of inhibiting PDI by use of Group 2 compounds.
6. Claims 12-15, 19, 35 drawn to a method of inhibiting PDI by use of Group 3 compounds.
7. Claims 16-18, drawn to an assay method.

The claimed inventions are distinct.

Claim 1 has been “trisected”; one group is limited to those compounds that are encompassed by claim 2, those that are encompassed by claim 9, and those that go beyond these two claims. These three genera are distinct from one another; the structures of the compounds are different, the properties are different, and different searches are required.

Inventions {1-3} and {4-6} are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)). Nevertheless, in the event that any of Groups 1-3 is elected, and claims therein found allowable, the corresponding method-of-use claims will be rejoined for further examination provided that the limitations present in the claims (drawn to compounds) are incorporated into the method claims [*In re Ochiai* (37 USPQ2d 1127)]. For example, claim 19 would have to be amended to make it clear that the following two conditions are met: (a) certain specific compounds must be administered to a mammal as part of the claimed method, and (b) those certain specific compounds are the same as were found allowable in the Group 1, 2 or 3 claims. (An exception may be made for phenylarsine oxide *per se*).

Applicant is advised that for the response to this requirement to be complete, an election of the invention to be examined must be indicated, even if the requirement is traversed (37 C.F.R. 1.143).

Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with

37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently filed petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(h).

. . . . .

In addition to the foregoing, applicants are required under 35 U.S.C. §121 to elect a disclosed specie for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. A "specie" is a specific compound, with all substituent variables fully accounted for. For example, if Group 1 is elected, both of variables R and R' would have to be fully defined.

Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a generic claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

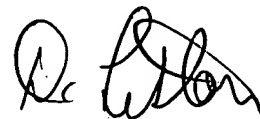
Upon allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentable distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103 of the other invention.

✱

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton. Phone: (703) 308-3213.

An inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



DAVID LUKTON  
PATENT EXAMINER  
GROUP 1800